

REMARKS

Claims 1-4, 8-11, 16 and 21-36 are pending in the above-identified application. Claims 1 and 2 have been amended so as to correct a minor formal matter.

Certified Copy of Priority Document Not Needed

The Office Action indicates that a certified copy of the Priority Document for the present application, i.e. German Patent Application No. 19701446.1 must be submitted. However, this is incorrect, since the priority document requirements have already been satisfied in connection with the parent application USSN 09/091,300 as evidenced by the enclosed copy of the Notification of Acceptance dated September 1, 1998. Note that this Notification indicates that the "Priority Document" was indeed already received in 1998 by the USPTO. No re-submission of the Priority Document is required. It is requested that the next communication from the Examiner confirms that this is true.

Restriction Requirement and Election Requirement Issues

Applicants respectfully maintain the traversal of the Restriction Requirement and the Election Requirement for the reasons indicated in the Reply filed December 20, 2004.

It appears that claims 1-4, 8-11, 14, 16, 21, 35 and 36 all fall within the definition of Group I as defined in the Office Action of September 20, 2004. All of these claims include substituent "X" as being CR¹⁰R¹¹; and substituent "Y" being oxygen, sulfur, or NR¹². It is respectfully requested that the next communication from the Examiner confirm that indeed all of these claims do fall within Group I.

In addition to the above, it is respectfully submitted that at least claim 23 should also be included within Group I, since claim 23 is directed to a method of using the compounds defined in either claim 1 or claim 2. It is submitted that there is no undue burden placed on the Examiner for examining method-of-use claim 23 in addition to the elected subject matter within Group I, since the prior art search and substantive examination issues significantly overlap. In fact, it would appear that the search issues completely overlap.

Issues Under 35 U.S.C. 103(a)

Claims 1-4, 8-11, 14, 16, 21, 24-32, 35 and 36 have been rejected under 35 U.S.C. 102(a) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Adachi '105 (WO 97/41105) which corresponds to Chemical Abstracts CAS:127:346402.

It is noted that the earliest effective prior art date of Adachi '105 is November 6, 1997 (the PCT publication date). It is further noted that the present application is a Continuation of pending Application No. USSN 09/091,300 which is a national stage PCT application having an international PCT filing date of January 8, 1998 and a Priority Date of January 17, 1997 (based on the filing of an application in Germany).

Applicants intend to submit a verified English translation of the Priority Document, i.e. German Application No. 197 01 446.1 filed in Germany on January 17, 1997. This verified translation is expected to be forwarded in the near future. Submission of such a verified translation supporting the full scope of the present claims would remove Adachi '105 as effective prior art under 35 U.S.C. 102 and 103 such that this rejection would have to be withdrawn.

Double Patenting Issue

Claims 1-4, 8-11, 14, 16, 21, 24-32, 35 and 36 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of Bratz '437 (USP 6,479,437). It is requested that this double patenting rejection be withdrawn based on the following reasons.

Bratz '437 is directed to a herbicidal mixture which includes (a) a compound of formula I, and (b) a nitrogenous fertilizer in a synergistically effective amount, plus (c) an adjuvant. The compounds of formula I of Component (a) overlap with the compounds recited in claim 1 of the present application, for example. However, the claims of the present application do not recite the presence of any nitrogenous fertilizer (b) as required by the herbicidal mixture claimed in claims 1 and 2 of Bratz '437.

Two-Way Obviousness Double Patenting Standard

It is submitted that the present application should be subjected to a "two-way obviousness" double patenting analysis as described at MPEP 804, section II.B.1(b), Rev.2, May 2004, pp. 800-23 to 800-24. The present application is a Divisional Application based on a parent PCT application which entered into the national stage at the USPTO on June 16, 1998, almost 18 months earlier than the national stage entry into the USPTO of Bratz '437 of December 5, 2000. Thus, Bratz '437 was prosecuted before the USPTO much more quickly than the parent application (i.e. USSN 09/091,300 still pending) or the present application which was filed in the USPTO on December 27, 2000 (a few weeks later than the national stage entry into the USPTO of Bratz '437). Consequently, the present application and prosecution situation correspond to the line of cases including: *General Foods Corp. v. Studiengesellschaft Cohle*

GmbH, 972 F.2d 1272, 23 USPQ2d 1839 (Fed. Cir. 1992); and *In re Braat*, 937 Fed. 2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991). These cases essentially held that the two-way obviousness analysis was required in order to address the double patenting issue that was raised in connection therewith.

Application of Two-Way Obviousness Standard

The two-way obviousness standard requires that the claims of the present earlier-filed application be considered “obvious” assuming that the claims of the later-filed patent Bratz ‘437 are hypothetical “prior art”; **and** that the reverse analysis also results in a conclusion of obvious. In the present situation, it is clear that if the claims of the present earlier-filed application are hypothetically presumed to be “prior art”, the claims of Bratz ‘437 would not be “obvious” or unpatentable, since the claims of Bratz ‘437 require the additional presence of a nitrogenous fertilizer (b) which is neither disclosed nor suggested by any of the claims of the present earlier-filed application under consideration.

In view of the above, it is submitted that the basis for the double patenting rejection has been removed such that this rejection should be withdrawn.

Response to Objection to Claims

Item (9) at page 10 of the Office Action describes an objection to claims 1-4, 8-11, 14, 16, 21, 24-32, 35 and 36. As noted above in connection with the Restriction Requirement, it is submitted that claims 1-4, 8-11, 14, 16, 21, 35 and 36 appear to all fall within the definition of Group I as defined in the Office Action of September 20, 2004. Therefore, it is not understood

why these claims which all fall within Group I have objected to and it is requested that the Examiner clarify this point.

Possible Interview

Applicants' representative may request a personal Interview with the Examiner in the near future in order to attempt to resolve some of the issues described above.

Conclusion

It is submitted for the reasons stated above that the present claims define patentable subject matter such that this application should now be placed condition for allowance.

If any questions arise regarding the above matters, please contact Applicant's representative, Andrew D. Meikle (Reg. No. 32,868), in the Washington Metropolitan Area at the phone number listed below.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 02-2448, under Order No. 5000-0103PUS2 from which the undersigned is authorized to draw.

Dated: June 6, 2005

Respectfully submitted,

By 

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Enclosure: Notification of Acceptance for parent application USSN 09/091,300